UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte CHARLES EDWARD ANDERSON IV

_____

Appeal 2010-001598[1]
Application 10/080,671
Technology Center 2400

_____

Before: JOSEPH L. DIXON, LANCE LEONARD BARRY, and
CAROLYN D. THOMAS, *Administrative Patent Judges.*

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] An oral hearing was held on March 23, 2011.

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1-50. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

The claims are directed to system, method and computer program product for selectively caching domain name system information on a network gateway. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method for identifying frequently accessed domain names in a customer premises equipment that includes a memory and a communication interface, the frequently accessed domain names to be provided to a network gateway for use in domain name system caching, comprising the steps of:
> (a) searching files in the memory to identify the frequently accessed domain names; and
> (b) providing the frequently accessed domain names to the communication interface for transmission to the network gateway over a communication path;
> wherein the files in the memory comprise application data files that hold frequently accessed domain names.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Himmel	US 6,041,360	Mar. 21, 2000
Schiuma	US 2002/0065936 A1	May 30, 2002

REJECTIONS

Claims 1-9, 22-29, 39-45, 48, and 50 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Himmel. Ans. 3.

Claims 10-21, 30-38, 46, 47, and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel and Schiuma. Ans. 7.

ISSUES

Has the Examiner set forth a sufficient initial showing of anticipation of independent claim 1 under 35 U.S.C. § 102?

Has the Examiner set forth a sufficient initial showing of obviousness of independent claim 10 under 35 U.S.C. § 103?

PRINCIPLES OF LAW

35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

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35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, "'there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently . . . ." *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001).

ANALYSIS

35 U.S.C. § 102

The Examiner has rejected independent claims 1, 22, and 39 and Appellant has argued these independent claims as a single group. (App. Br. 15-17). Therefore, we will address Appellant's arguments with respect to independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that claim language "to a network gateway for use in domain name system caching" means that the frequently accessed domain names are "stored at a network gateway instead of being stored only at the customer premises equipment (as is conventionally done)." (Reply Br. 2). Appellant further contends that independent claim 1 recites "identifying the frequently accessed domain names and providing the domain names to a communication interface for transmission to the network gateway." (*Id.*). Appellant further contends that the teachings of Himmel are entirely different and Himmel is "not concerned with providing frequently accessed domain names to a network gateway (i.e., a domain name system caching)." (*Id.*). We disagree with Appellant. The Examiner argues that the claim language "for use in domain name system caching" has not been given patentable weight because the recitation occurs in the preamble and the Examiner fails to find any mention of domain system caching actually performed at the network gateway in the body of independent claim 1. (Answer 13-14). We agree with the Examiner that the claimed "for use in domain name system caching" is only a recitation of an "intended use" of the claimed invention which does not result in any structural difference between the claimed method and the method disclosed in Himmel.

Appellant maintains that "[t]he server of Himmel is not analogous to the network gateway of the claims" (Reply Br. 4). As discussed above, the Examiner maintains that the "network gateway" and "domain name system caching" are part of an "intended use" statement wherein no structural elements are positively recited in the method of independent claim 1 and are not entitled to patentable weight. We agree with the Examiner's interpretation with respect to independent claim 1 and contrast independent claim 10, which is rejected under obviousness, which positively recites the network gateway and storing in the cache. Therefore, we find Appellant's argument to be unpersuasive of error in the Examiner's showing of anticipation of independent claim 1 and sustain the rejection of representative independent claim 1. Since the Appellant did not submit separate arguments for the patentability of independent claims 22 and 39, we will group those claims as falling with independent claim 1. Appellant did not set forth separate arguments for patentability of the other dependent claims beyond the ones specifically addressed below, therefore they will fall with their respective independent claims. See 37 C.F.R. § 41.37(c)(1)(vii).

With respect to dependent claims 2 and 3, the Examiner modifies the portion of the Himmel reference relied upon to teach initiating the steps. (Answer 15-16). We agree with the Examiner that columns 15-16 of Himmel better teaches initiating the steps during start up and/or periodically and sustain the rejection of dependent claims 2 and 3.

With respect to dependent claim 4, Appellant argues that the teachings of Himmel at column 5 are intended to be interpreted as not requiring "actions by a human operator." (App. Br. 17-18). While we agree with Appellant that the Himmel reference discloses their optimal embodiment for their invention, Himmel also discloses at column 5 that "the operations

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performed may be in response to user input" which is a sufficient teaching for anticipation of dependent claim 4. Therefore, we sustain the rejection of claim 4.

With respect to dependent claims 6, 26, and 41, the Examiner relies upon the teachings of Himmel at column 6, 7, 17, and 19 (Answer 5 and 16-17), and the Examiner maintains that Appellant admits that "MIME type information are associated with e-mail," but we find no teaching or disclosure in Himmel of an e-mail application and "searching application data associated with an electronic mail application" as recited in dependent claim 6. Appellant argues the teachings relied upon by the Examiner have nothing to do with the "searching application data associated with an electronic mail application." (Reply Br. 5). We agree with the Appellant. Therefore, we cannot sustain the rejection of dependent claims 6, 26, and 41 under anticipation.

With respect to dependent claim 7, Appellant contends that the Examiner's reliance upon the teachings of Himmel at column 1 says nothing of "packetizing the frequently accessed domain names" or of "providing the packetized information to the communication interface." (App. Br. 19). The Examiner further finds that packetized in the frequently accessed domain names is "inherent to an [sic] TCP/IP protocol suite" as taught in column 6 or "communicating via a Web browser on an Internet." (Answer 17). Appellant does not address the Examiner's further clarification of the teachings of Himmel. Therefore, we accept the Examiner's findings and sustain the rejection of dependent claim 7. At the Oral hearing Appellant's representative advanced an argument that the claimed invention requires plural "domain names" whereas Himmel may only be characterized as a single domain name at a time. This specific argument was not previously

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presented to the Examiner and therefore untimely. Furthermore, the teachings of Himmel clearly evidence that the system may be iteratively used to provide plural domain names wherein the claim language does not require plural domain names to be packetized at the same time.

With respect to dependent claims 8, 28, and 43, Appellant contends that the Examiner's reliance on the teachings of Himmel concerning a book mark list does not disclose "providing the management information based to the communication interface." The Examiner further identifies in the Answer at page 18 that figure 1 of Himmel teaches submitting the DNS entry, which the Examiner finds as a functional equivalent of the MIB. The Examiner states at page 18 of the Answer

> [t]o further add, Himmel discloses a DNS process per Col 6 lines 1-18. Per MPEP 2111, examiner has read the claims in light of applicant's disclosure per [0017] which states, 'The frequently accessed domain name may be provided in the form of a packet, in a Management Information Base (MIB), or a DNS query'[.]

(Answer 18). We agree with Examiner's analysis and conclusion. Therefore, we will sustain rejection of dependent claim 8.

The Appellant does not set forth separate arguments for patentability of the other dependent claims, therefore they will fall with their respective independent claims. See 37 C.F.R. § 41.37(c)(1)(vii).

35 U.S.C. § 103

With respect to independent claim 10, we agree with Appellant that the combination of Himmel and Schiuma do not teach or suggest the claimed "network gateway" capable of "storing the frequently accessed domain name and the corresponding IP address in the cache," as recited in independent claim 10. (App. Br. 22-23; Reply Br 6-8). Therefore, we

cannot sustain rejection of independent claim 10 and dependent claims 11-
20. Independent claims 21 and 30 contain similar limitations as independent
claim 10. Therefore, we cannot sustain rejection of independent claims 21
and 30 and their respective dependent claims.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 1-5, 7-9, 22-25, 27-29,
39, 40, 42-45, 48, and 50 under 35 U.S.C. § 102(e) as being anticipated by
Himmel.

The Examiner erred in rejecting:

claims 6, 26, and 41 under 35 U.S.C. § 102(e) as being anticipated by
Himmel; and

claims 10-21, 30-38, 46, 47, and 49 under 35 U.S.C. § 103(a) as being
unpatentable over Himmel and Schiuma.

DECISION

For the above reasons, the Examiner's rejection of claims 1-5, 7-9, 22-
25, 27-29, 39, 40, 42-45, 48, and 50 under 35 U.S.C. § 102 is affirmed;
claims 6, 26, and 41 under 35 U.S.C. § 102 is reversed; and the Examiner's
rejection of claims 10-21, 30-38, 46, 47, and 49 under 35 U.S.C. § 103(a)
reversed.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED-IN-PART

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